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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,235	01/13/2000	John L. Wood	OCR-729/756	6715

7590 09/26/2003

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/26/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/482,235

Applicant(s)
WOOD et al.

Examiner
Brenda Coleman

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 14, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 8-17, and 19-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 8-17, and 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1624

DETAILED ACTION

Claims 1, 3-5, 8-17 and 19-25 are pending in the application.

This action is in response to applicants' amendment dated July 14, 2003. Claims 1, 3 and 17 have been amended and claim 25 is newly added.

Response to Arguments

Applicants' arguments filed July 14, 2003 have been fully considered with the following effect:

1. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection labeled paragraph 2a) of the last office action, which is hereby **withdrawn**.
2. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 3 of the last office action, which is hereby **withdrawn**.
3. With regards to the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 4) of the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicants stated that the substituent and/or functional group X is supported in the present specification". The applicants pointed to page 7, Reaction Scheme III of the specification, where "X represents S and/or O". However, this definition is in respect to the cyclic acetal moiety not the open congeners. See claims 1 and 17.

Art Unit: 1624

Claims 1, 3-5, 8-17 and 19-25 are rejected under 35 U.S.C. § 112, first paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For reasons of record and stated above.

4. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections in labeled paragraph 5) of the last office action, which are hereby **withdrawn**.

5. With regards to the 35 U.S.C. § 102 anticipation rejection of claims 1, 3-5, 8-17 and 19-24 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The instant claims are not described in the applicants priority document and thus are only entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 as it is only completely described in the U.S. Application No. 09/206,082 filed December 4, 1998. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120.

Claims 1, 3-5, 8-17 and 19-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Tetrahedron Letters. For reasons of record and stated above.

6. With regards to the 35 U.S.C. § 102 anticipation rejection of claims 1, 3-5, 8-17 and 19-24 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The instant claims are not described in the applicants priority document and thus are only entitled to benefit of U.S. Application No. 08/817,230 filed June 4, 1997 as it is only

Art Unit: 1624

completely described in the U.S. Application No. 09/206,082 filed December 4, 1998. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120.

Claims 1, 3-5, 8-17 and 19-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., Journal of American Chemical Society. For reasons of record and stated above.

In view of the amendment dated July 14, 2003, the following new grounds of rejection and/or reinstated rejections apply:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 17 and 19-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the process of claim 17 where R includes the moiety Me optionally partially or fully halogenated is not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1624

8. Claims 1, 3-5, 8-17 and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1, 3-5, 9, 13-17 and 20-25 are vague and indefinite in that it is not known what is meant by the definition of the acetal having the ring structure, which is not stated in the form of a proper Markush group. See claims 1 and 17.
- b) Claims 1, 3-5, 9, 13-17 and 20-25 are vague and indefinite in that it is not known what is meant by the definition of the acetal having the ring structure, where the second moiety is not a ring. See claims 1 and 17.
- c) Claim 8 recites the limitation "methyl" in three places on the structure of the furanose. There is insufficient antecedent basis for this limitation in the claim. R cannot be methyl.
- d) Claim 8 recites the limitation "methyl" in the two structures. There is insufficient antecedent basis for this limitation in the claim. R cannot be methyl.
- e) Claims 8, 12 and 13 are vague and indefinite in that it does not end with a period.
- f) Claim 11 recites the limitation "K252a" in the final product prepared by the process according to claim 1. There is insufficient antecedent basis for this limitation in the claim. The structure of the K252a includes methyls.
- g) Claim 12 recites the limitation "methyl" in the three structures. There is insufficient antecedent basis for this limitation in the claim. R cannot be methyl.

Art Unit: 1624

- h) Claim 12 recites the limitation "HOCH₂-" in the second structure. There is insufficient antecedent basis for this limitation in the claim.
- i) Claim 16 is vague and indefinite in that it is not known what is meant by "diazolaactam".
- j) Claim 17 is vague and indefinite in that it is not known what is meant by "reacting an indolocarbazole having the ring structure.... by reacting a diazo compound having the ring structure...".
- k) Claim 19 recites the limitation "K252a" in the final product prepared by the process according to claim 17. There is insufficient antecedent basis for this limitation in the claim. The structure of the K252a includes methyls.
- l) Claim 25 recites the limitation "Me, CO₂Me, DMB, PMB" in the definition of R. There is insufficient antecedent basis for this limitation in the claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1624

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
September 25, 2003